

REMARKS

Claims 1 and 2 are pending in this application. The Office Action objected to the specification for failing to provide antecedent basis for the claimed subject matter. The Office Action also rejected Claim 1 under 35 U.S.C. § 112. The Office Action further rejected Claim 1 under 35 U.S.C. § 102. Finally, the Office Action rejected Claim 2 under 35 U.S.C. § 103.

Objection to the Specification

The Office Action objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. With respect to the term "an elongated continuous cylindrical sleeve" in Claim 1, the Office Action stated that there is no support for the term "continuous." Applicant submits that the term continuous is inherent by use of the term "cylindrical." By definition, a cylindrical shape is continuous. For example, Merriam-Webster defines a "Cylinder" as "the surface traced by a straight line moving parallel to a fixed straight line and intersecting a fixed planar **closed** curve." [emphasis added] Hence, a cylinder is always continuous. Applicant has amended the specification to explicitly state that the cylinder is continuous and closed. Figure 1 and the ordinary definition of cylinder support this amendment. Therefore, no new matter is added.

With respect to the term "said features are positioned on the exterior face, between said lower rim and said upper rim" in Claim 1, the Office Action stated that there is no support for such location of the features. Applicant submits that Figure 1 shows an upper rim (12) and a lower rim (14), and character features (18,16,20,22). Also, on Page 2 of the specification it is stated that "To provide this appearance, feature of an animal, aligned with the longitudinal axis of the cylinder, are provided substantially along half of the warmer's circumference. Preferably, the features are aligned so as to create the illusion that the character's eyes are to be located just above the upper rim 12 of the neck warmer 10." Hence, the features are provided below the upper rim 12, and subsequently above the lower rim 14.

With respect to the term "the nose indicia is positioned on the exterior face closer to said lower rim than said nose indicia," the Office Action stated that there is no antecedent basis. Applicant has amended the specification to recite that "Figure 1

indicates a mouth indicia and a nose indicia whereby the mouth indicia is closer to the lower rim than the nose indicia." Figure 1 clearly shows a mouth indicia 16 closer to a bottom rim 14 than a nose indicia 18. Therefore, no new matter is added.

Rejection of Claim 1 under 35 U.S.C. § 112

The Office Action rejected Claim 1 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action stated that the claim term "but not including the eyes" was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention and that on page 3, lines 10-13, the specification states that eyes can be used in combination on the neck warmer. Applicant respectfully disagrees with the Office Action that the term "but not including the eyes" is not supported by the specification. First, each of Figures 1 and 2 clearly illustrate a neck warmer having features of a character, "not including the eyes." Next, on Page 2, line 20, the specification states that "the features are aligned so as to create the **illusion** that the character's **eyes** are to be located just **above** the **upper** rim 12 of the neck warmer 10." [emphasis added] An "illusion" is known in the art to indicate that something is missing or is made to appear where it is not. In the context of the discussion above, "illusion" clearly refers to the fact that the displayed features suggest the presence of a feature in an imaginary location, i.e., above the upper rim. Obviously, it is a physical impossibility to provide any feature outside the surface of the neck warmer (above the upper rim). Hence, the only reasonable conveyed meaning to one of ordinary skill in the art from Figures 1 and 2 as well as the discussion of Page 2, is that the features do not include eyes, which, if provided (such as by a child wearing the warmer), "are to be located" above the upper rim of the neck warmer.

The Office Action also stated that the embodiment disclosed on Page 3, which lists eyes as one features to be provided on the neck warmer limits the claims to such embodiment. Applicant respectfully submits that the specification discloses other embodiments that support the pending claims. The disclosure of several alternate embodiments should not serve to limit the claims. There is not statement in the specification indicating that the character eyes are essential features of the invention or

any other indication that the embodiment on Page 3 includes essential features. Therefore, Claim 1 does not violate the written description requirement since the specification did not describe the features as essential or critical to the operation or patentability of the claim. See In re Peters, 723 F. 2d 891, 221 USPQ 952 (Fed. Cir. 1983).

Rejection of Claim 1 under 35 U.S.C. § 102

The Office Action rejected Claim 1 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,823,868 to Begum (Begum). Specifically, the Office Action stated that Begum teaches a travel mask that is capable of warming the neck, is an elongated continuous cylindrical sleeve, and includes the indicia of Claim 1 in the respective positions recited in Claim 1. Applicant respectfully disagrees with the Office Action that Begum anticipates Claim 1.

Begum does not disclose a neck warmer. The Office Action points to Figure 6 in stating that Begum is capable of warming the neck. However, even if one assumes that Begum discloses a mask that can warm a neck, Figure 6 shows exposed portions of a neck, with only the wearer's chin being covered. Begum states that "the traveler in FIG. 6 has the cloth-like surgical mask 14 installed over the wearer's lower face." A person of ordinary skill in the art is not likely to conclude that "lower face" includes the neck. Merriam-Webster Dictionary defines "face" as "the front part of the human head including the chin, mouth, nose, cheeks, eyes, and usually the forehead." Hence, Begum should be reasonably interpreted to disclose a mask worn over a wearer's face, which does not include the neck. There is no disclosure in Begum indicating that the mask would inherently be capable of serving as a neck warmer while still providing the function of a character mask, as recited in Claim 1. When relying on the theory of inherency, the examiner must provide a basis in fact to reasonably support the determination that allegedly inherent characteristics necessary flow from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). In the present case no such showing was made to indicate that the face mask of Begum serves to warm a wearer's neck. Therefore, Claim 1 is allowable over Begum for at least this reason alone.

Moreover, Begum does not disclose an "elongated continuous cylindrical sleeve." The Office Action stated that Begum discloses an elongate continuous cylindrical sleeve in Figures 1 and 2. The masks of Figures 1 and 2 are not continuous cylindrical sleeves. The ordinary meaning of "cylindrical sleeve" is a tubular object which has a top opening and a bottom opening. The term "cylindrical sleeve" is known in the art and is widely used to describe such tubular shapes. The mask of figure 1 is not a cylindrical sleeve since significant portion of the mask's circumference is traced by "an elastic strap 20 connected to the face shield 16 by staples 22." Such combination of a face shield and strap is clearly not a cylindrical sleeve as understood in the art. With respect to Figure 2, the "elastic loops 28" do not even form a complete circle, in combination with the face shield. Moreover, neither the mask of Figure 1 nor the mask of Figure 2 are continuous, as recited by Claim 1. As discussed above, the mask of Figure 1 is a combination of a face shield and an elastic strap, connected by staples. This combination of strap, staples, and shield is clearly not continuous. With respect to Figure 2, as discussed above, the elastic loops never meet to form any continuous surface resembling a cylinder. Accordingly, Claim 1 is allowable over Begum for at least this reason alone.

There is no disclosure in the prior art, or Begum specifically, of a combination mask and neck warmer as recited by Claim 1. The Office Action recites a mask as part of a 35 U.S.C. § 102(e) while disregarding the elements of the neck warmer derived from its function as a neck warmer by stating that the mask can be worn around the neck. However, as discussed above, such manipulation of an mask would defeat its purpose as a mask. Moreover, there is no suggestion in any of the prior art that it would have been obvious to one of ordinary skill in the art at the time of invention to provide a neck warmer which provides the function of a mask, as recited in Claim 1. Accordingly, Claim is patentable over Begum and the teachings of the prior art in general.

Rejection of Claim 2

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Begum. Specifically, the Office Action stated that Begum fails to teach the entire covering being made out of fleece material. However, the Office Action stated that Begum teaches the nose baffle made of padded fleece material, with the rest made of close-weave micro fiber material. Thus, the Office Action concluded, it would have been

obvious to one having ordinary skill in the art to have provided the covering in any material that was soft to the user's skin and provides insulation, as stated in the specification on page 2, lines 9-11. Therefore, the micro-weave material would be interchangeable with fleece due to its insulation properties and softness. Applicant disagrees with the Office Action that micro-weave material is equivalent to fleece.

Micro-weave material is not interchangeable with fleece. The Office Action stated that close-weave micro fiber material of polymer and cotton is equivalent to fleece material without any support in the prior art. If the Office Action is taking judicial notice of such equivalency, applicant objects to such taking notice and requests a showing of such equivalency in the prior art. Moreover, the prior art at hand is counter to finding of such equivalency by Begum employing both micro fiber material and fleece in the same mask. If the two were indeed the same, there would be no need to use one for some portions of the mask and the other for other portions. Accordingly, Begum suggests away from such equivalency by using such materials for different functional elements of the mask.

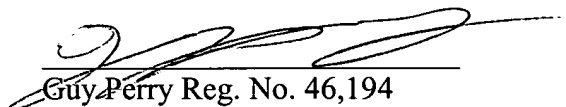
SUMMARY

Applicant has provided arguments in support of Claims 1 and 2. The Application is believed to be in condition for allowance with Claims 1 and 2.

If the Examiner wishes to direct any questions concerning this application to the undersigned Applicant's representative, please call the number indicated below.

Dated: September 20, 2005

Respectfully submitted,


Guy Perry Reg. No. 46,194

Attorneys for Applicants
(212) 735-3000
Skadden, Arps, Slate, Meagher & Flom LLP
Four Times Square
New York, NY 10036